

REMARKS

Favorable reconsideration of this application is respectfully requested.

Claims 1-3, 5- 17, 19-24, and 26-28 are pending in this application. Claims 4, 18, and 25 were previously canceled without prejudice or disclaimer.

The outstanding Office Action presents a rejection of Claims 1, 5, 15, 19, 22, and 26 as being anticipated by Maeda et al (U.S. Patent No. 6,005,834, Maeda), and a rejection of Claims 2, 3, 6, 7, 16, 17, 20, 21, 23, 24, 27, and 28 as being unpatentable over Maeda in view of Funada (U.S. Patent No. 4,730,294) under 35 U.S.C. § 103(a).

Initially, Applicants gratefully acknowledge the indication in the outstanding Office Action that Claims 8-14 are allowable over the prior art.

WITHDRAWAL OF IMPROPER ACTION

The "Response to Remarks" set forth at page 2 of the outstanding Action does not reasonably address the points raised at pages 2-7 of the response filed August 6, 2003. Thus, even though the outstanding Action repeats the rejections of the previous Action, it does not follow the guidelines of MPEP §707.07(f) requiring the provision of clear explanations and that any Action repeating previously made rejections is to answer the substance of all arguments made in traverse thereof.

In this last regard, page 2 of the outstanding Action does provide any explanation as to withdrawing the indication of allowability previously made with respect to the subject matter of Claims 1, 15, and 22. Not only is no clear explanation made, there is also no attempt made to answer the points made at pages 2-3 of the response filed August 6, 2003.

These points are repeated as follows:

As was noted in the preliminary amendment filed on April 18, 2003, Claims 4, 18, and 25 were canceled and their subject matter was included in respective independent Claims 1, 15, and 22 to effectively rewrite Claims 4, 18, and 25 in independent form. As further indicated in this preliminary amendment, this was done to overcome the objection in the Office Action mailed November 18, 2002, that only objected to Claims 4, 18, and 25 as being dependent upon a rejected base claim and further stated that Claims 4, 8, and 25 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Further in this regard, the Office Action mailed November 18, 2002, stated the following "Examiner's statement for the indication of allowable subject matter:"

As in Claims 4, 18, and 25, the prior art of record fails to teach or fairly suggests an optical information recording/reproducing apparatus having an optical pickup for making a light beam emitted from a light source incident on a recording medium via a two-group objective lens so as to record or reproduce optical information on or from said recording medium wherein a cycle of the cyclic change in a distance between said first lens and said second lens is longer than a cycle of the cyclic movement of said at least one of said first lens and said second lens.

Thus the Examiner then recognized then that the actual claim limitation required that there must be "a cycle of the cyclic change in a distance between said first lens and said second lens" and that this "cycle" of the distance that is created between the first lens and the second lens must be "longer than a cycle of the cyclic movement of said at least one of said first lens and said second lens." These statements further clearly require that the change in distances has to relate to cyclic movement where a "cycle" clearly relates to a periodic cycle that must repeat over time if the required plain meaning of "cycle" to the worker of ordinary skill in the art is used, as it must be. See In re Cortright, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999) ("Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.").

Having stated the relevant claim limitation in a manner recognizing that more than a simple distance between lenses is recited by the language "wherein a cycle of the cyclic change in a distance between said first lens and said second lens is longer than a cycle of the cyclic movement of said at least one of said first lens and said second lens," it is believed to be clear error to

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now ignore the very language of the claims previously stated to be allowable subject matter.

Not only does the outstanding Action fail to present any explanation for the above-noted change in position or any answer to the points raised as to the Cortright decision, the previous Action and the present outstanding Action both fail to provide any indication of express approval by the primary examiner in accordance with MPEP §706.04. In this regard, MPEP §706.04 requires “consideration of all the facts and approval of the proposed action” and that “great care” must be exercised in authorizing such a rejection of subject matter previously stated to be allowable.

In addition to the fact that neither the outstanding Action nor the previous Action include any express Primary Examiner approval of the withdrawal of the previously indicated allowability of the subject matter of Claims 1, 15, and 22, the copy of the outstanding Action mailed on October 21, 2003, to Applicants’ representative includes absolutely no signature, Primary Examiner or otherwise.

Accordingly, it is respectfully submitted that the present outstanding unsigned Office Action should be withdrawn. In addition, if the PTO is to continue to place reliance on the above-noted repeated rejections, a replacement Action should be provided that is a complete Action that is properly signed and contains express Primary Examiner approval of the above-noted withdrawal of the previously indicated allowability of the subject matter of Claims 1, 15, and 22. Such an appropriate replacement Action should also include an appropriate explanation of the change in position by the PTO along with answers to the arguments made above as to the interpretation of claim language as well as the further arguments appearing below.

FURTHER UNANSWERED ARGUMENTS

As noted above, Claims 1, 5, 15, 19, 22, and 26 clearly require that the changes in distances recited by virtue of the base claim recitations of cyclic movement where a “cycle” clearly relates to a periodic cycle that must repeat over time if the required plain meaning of “cycle” to the worker of ordinary skill in the art is used, as it must be. See again the above-noted Cortright decision. Further note that MPEP §2111.01 emphasizes that the words of a claim must be given their plain meaning and that this “plain meaning” is the one the worker of ordinary skill in the art would arrive at.

Instead of addressing these points, the outstanding Action improperly creates teachings as to “recurring motion” (emphasis added) of a linear lens movement taught by Maeda as to following changes in disk thickness. The question is where does Maeda teach that there are any recurring changes in disk thickness, much less that such changes are recurring in a manner that can reasonably be said to be cyclic? As explained in the last response and noted in detail below, In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993), requires that “[w]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.” Instead of any indication of any “recurring motion” (emphasis added) or “recurring” (emphasis added) changes in disc thickness discussion in Maeda, the PTO simply substitutes its improper subjective conclusion that the motion and disc thickness variation have this nature. Such substitutions of subjective conclusions that go beyond the actual reference teachings violates established precedent. See In re Kotzab 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) noting that subjective premises cannot substitute for the

required substantial evidence needed to support any valid rejection.

Moreover, the last response pointed out that there was also absolutely nothing but conjecture and subjective opinion being offered (in the place of actual evidence) to support the conclusion of the last Action as to various claimed distance relationships being somehow reasonably taught by Maeda, as follows:

In this last regard, the new rationale offered to support the rejection of these claims as being anticipated by Maeda is that “one of the lenses 36 or 37 moves a distance d_1 , the change in a distance d_2 between the first lens and the second lens 37 is the distance d_2+d_1 and therefore $d_2+d_1>d_1$.” However, the claim language in question does not simply state that a lens is moved from one position separated from another lens to a new position even further separated from that lens, which is clearly the inappropriate modification of actual claim language relied on.

First of all, the question is the distance a first lens travels relative to a second lens as it moves in a periodic cycle of overall movement. The interpretation offered includes nothing that can be reasonably said to be a cycle as to the simple linear movement of the first lens from a first point (a distance d_2 from the second lens) to a second point (a distance d_1+d_2 from the second lens).

Moreover this attempted over simplification of the actual claim language ignores the clear claim language requiring that the distance moved by the first lens in its “cycle” of movement relative to the second lens must be “longer than a cycle of the cyclic movement of said at least one of said first lens and said second lens” where this “cyclic movement” of “at least one of said first lens and said second lens” has already been recited by these claims as being the result of the movement “by said moving means.” The movement of the first lens away from the second lens of Maeda is still d_1+d_2 and d_1+d_2 cannot be greater than itself.

Rather than address how a lens that moves a distance d_1 along with another lens can be said to move a distance d_2 from that another lens, the outstanding Action simply repeats the faulty analysis of the previous Action at page 4 that because “one of the lenses 36 or 37 moves a distance d_1 , the change in a distance d_2 between the first lens and the second lens 37

is the distance $d_2 + d_1$ and therefore $d_2 + d_1 > d_1$.” Clearly, focus control movement is described at col. 5, lines 21-29, as a movement of the lens holder 59 that “causes the two group lens to move in the direction of optical axis thereof.” There is nothing at col. 4, lines 15-19, indicating that this focus movement of the two lenses involves a movement of one lens a distance d_1 from the other. Moreover, even if this d_1 movement were taught, as it is for correcting spherical aberrations at col. 7, lines 15-20, the change in distance between the two lenses cannot be any distance other than the distance d_1 moved by the one moving lens. Clearly, the attempt to create a separate distance moved that is d_2 , instead of the actual distance moved that is d_1 , is not based upon any teaching in Maeda.

Thus, even though MPEP §707.07(f) requires that the provision of clear explanations and that an Action is to answer the substance of all arguments made when repeating rejections, the outstanding Action simply and improperly ignores these points. In addition, the outstanding Action further ignores the points raised in the last response that:

As has been previously emphasized to the PTO, it is clear error to fail to take each and every word of a claim into account in determining the subject matter thereof. See In re Wilson, 165 USPQ 494, 496 (CCPA 1970).

Furthermore, and as fully discussed in the amendment filed July 29, 2002,

the meaning of “cycle” is well understood to be “an interval of time during which a sequence of a recurring succession of events or phenomena is completed” see Meridian Webster’s Collegiate Dictionary, 10th Edition”, 1996, page 288. As this page of this standard dictionary further indicates, it is well understood that cyclically is an adverb describing something as being related to a cycle. Thus, it is unmistakable that for anything to be reasonably described as cyclical, some parameter thereof must be shown to be recurring in a repetitive sequence.

The clear meaning of “cycle” to even the layperson notwithstanding,

the PTO once again would either erroneously read this word out of the rejected claims or apply an interpretation completely outside the boundaries of reason in order to improperly reject Claims 1, 5, 15, 19, 22, and 26 as being anticipated by Maeda.

Not only does the outstanding Action commit clear error by ignoring the word "cycle" or applying a totally unreasonable interpretation to it as to the above noted claim language, it also continues to improperly ignore it or unreasonably interpret it as to the claimed moving means that must "cyclically" move at least one of the first lens and second lens in an optical axis direction. As the amendment filed July 29, 2002, further noted:

As a sequence of a recurring succession of movement values is the key requirement to reasonably describing any movement to be cyclic, a showing of how Maeda teaches such a recurring succession of movement values is needed to support this rejection. However, the outstanding Office Action makes no attempt to point out where in Maeda such a teaching is to be found contrary to PTO reviewing court requirements (see In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) ("When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.")). Thus, the outstanding Office Action is deficient in relying on the focus control movement of Maeda that is entirely dependent upon detected focus conditions relative to a particular medium with no guaranty of any recurring movement sequences.

Furthermore, while the United States Patent and Trademark Office is to give claim language its broadest reasonable interpretation, it is well established to be unreasonable to attempt to interpret words well understood by the artisan in a completely unrealistic manner. See In re Cortright, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). Thus, simply reading the cyclical optical axis direction movements required by Claims 1, 15, and 22 on any focusing movement made in the optical axis direction is a clearly improper and erroneous interpretation. Accordingly, while cyclical may be a broader recital than one reciting the preferred sine wave movement (note Figure 6A, for example), it still require some form of cyclical movement not met by the simple focus control movement of Maeda.

Besides the fact that Maeda neither teaches nor suggests

any cyclical movement for the two-group objective lens in the direction of the optical axis as noted above, it also neither teaches nor suggests any use of reproducing signals obtained from the recording medium at one or more points of this cyclic movement as these claims also require. Once more the limitations positively set forth by Claims 1, 15, and 22 have been improperly ignored in making the outstanding rejection.

Even the improper attempted reliance on merely asserted results as to positional lens adjustments is repeated at the bottom of page 4 of the outstanding Action with absolutely no attempt made to address the points and authorities raised at pages 6-7 of the last response as follows:

Apparently realizing that much is missing in Maeda, the outstanding Action attempts to improperly rely on "the positional adjustment of lens based on reproducing signals such as tracking addresses is an inherent feature" as if it is reasonable to assume that it is impossible to have an optical information recording/reproducing apparatus not performing positional adjustment of a lens based on reproducing signals such as tracking addresses. This is clearly not the case and the assumptions made in the outstanding Action as to inherency merely relating to one possibility are again clearly erroneous. As further explained in the amendment filed July 29, 2002, inherency cannot be established absent a showing that something must absolutely occur, not simply that something might possibly occur. Thus, in order to establish inherency, the PTO reviewing court in In re Robertson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) has noted that the evidence:

[M]ust make clear that the missing descriptive matter is necessarily present in the thing described in the reference, that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Thus, before there can be said to be any inherency in positioning lenses on the basis of a reproducing signal or reproduced tracking addresses, it must be clear that no other manner of positioning a lens for such an apparatus was known. Clearly, as many lens positioning techniques are and were used for focus correction that do not require any "positional adjustment of a lens based on reproducing signals such as tracking addresses," the

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reliance on inherency is without merit¹.

Furthermore, and as noted above, lenses 36 and 37 are moved in unison during relied upon focus control operation. It is only during aberration correction that the distance between lenses 36 and 37 is taught by Maeda to change.

Accordingly, for all the above-noted reasons, the rejection of base independent Claims 1, 15, and 22 as being anticipated by Maeda is once again respectfully traversed.

With regard to Claim 5 dependent upon Claim 1, Claim 19 dependent upon Claim 15, and Claim 26 dependent on Claim 22, each of these dependent claims clearly defines over anything reasonably taught or suggested by Maeda for the same reasons as the respective parent claim does. In addition, each of these dependent claims includes further features in addition to those recited by its respective independent claim, which added features are further not taught or suggested by Maeda. Thus, these dependent claims are believed to patentably define over Maeda for this reason as well.

With respect to Claims 2, 3, 6, and 7 and as set forth in the last response, these claims all depend on Claim 1. In addition, Funada in no way cures any of the above-noted Maeda deficiencies. Accordingly, Claims 2, 3, 6, and 7 clearly patentably define over Maeda considered alone or in any proper combination with Funada for at least the reasons that parent Claim 1 does. In addition, and as also noted in the last response, each of Claims 2, 3, 6, and 7 adds further features not taught or suggested by Maeda and/or Funada considered

considered to patentably define over Maeda and/or Funada considered alone or together in any proper combination because of these added features. Note, for example the required “low band filter” of Claim 6 or “high band filter” of Claim 7..

Page 10 of the outstanding Action attempts to once again erroneously interpret rectifier 35 of Funada as something that the artisan would interpret to be a filter. However, a filter and a rectifier are clearly understood to be different elements performing entirely different functions. A filter passes certain frequencies of an input signal while rejecting other frequencies of that input signal. A rectifier is a diode like device that converts alternating current (ac) to direct current (dc).

Moreover, the rectifier 35 of Funada does not even “rectify” the information (reproduced) signal from 33. In this regard, Funada does not teach DC offset to have any thing to do with the envelope of the reproduced information from 33, it comes from battery 38 when switched by 37 and is added to a completely different focus error signal from split-beam detector 41 that is different from the detectors 42 and 43 providing inputs to 33 to provide the reproduced information signal.

With further regard to Claims 16, 17, 20, and 21 it is noted that each of these claims depend from Claim 15 such that they clearly patentably define over Maeda for the same reasons that parent Claim 15 does. In addition, it is again noted that Funada in no way cures the above-noted deficiencies in Maeda as fully discussed above. Accordingly, Claims 16, 17, 20, 21, are believed to clearly patentably define over Maeda taken alone or with Funada in any proper combination for all the reasons discussed above as to parent Claim 15. In addition, each of Claims 16, 17, 20, and 21 further clearly patentably define over Maeda

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taken alone or in any proper combination with Funada because of the features that each of these claims add to independent base Claim 15. Note again the added high and low band filters of Claims 20 and 21.

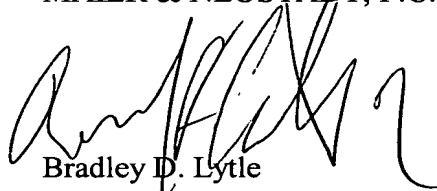
Turning to Claims 23, 24, 27 and 28, it is noted that each of these claims depends from base independent Claim 22. Again, as Funada cures none of the deficiencies noted above as to Maeda and base independent Claim 22 clearly patentably defines over these references taken alone or in any proper combination, so do these claims dependent thereon. In addition, these dependent claims add further features to base independent Claim 22 and these features also clearly patentably define over anything reasonably taught or fairly suggested by either Maeda taken alone or in any proper combination with Funada.

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In light of the foregoing and as no other issues are believed to remain outstanding relative to this application, it is respectfully submitted that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Bradley D. Lytle', is written over the printed name.

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